

Claim Rejections Under §112, ¶1

In the Office Action, claims 14-17, 35-37 and 45-50 were rejected under 35 U.S.C. §112, ¶1. Specifically, the Office Action states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. The Office Action alleges that the recitation in the subject claims of folding the strip layer over approximately in half to form a "V" is not described in the specification. Reconsideration of this rejection is respectfully requested.

The first paragraph of §112 reads as follows:

The specification shall contain a written description of the invention, and of the manner in process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. §112, ¶1(emphasis added).

"In order to determine whether a prior application meets the 'written description' requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed." *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). "Lack of literal support is not enough to support a rejection under §112 [but rather t]he test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date." *Eiselstein*, 52 F.3d at 1039. There is no requirement that the exact same words found in the claims appear in the specification. *Id.* The specification must only provide an equivalent description of the claimed invention "through use of other descriptive words, structures, figures, diagrams, formulas, and [so forth]." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). "To comply with the description requirement it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-2 (CCPA 1978).

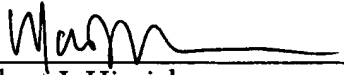
The same applies here. Claims 14, 16, 35, 45, and 48 refer to folding the strip label in approximately half to form a "V" for receiving the other form. This method refers to a second

method for assembling a third embodiment of the form where the user peels off and exposes the entire strip label and applies it "freehand" without the use of alignment markings found in the carrier portion of the form. This method is set forth on page 19, in lines 4-17. The specification states that once skill is acquired, the user may use the second alternative as a faster method in assembling and applying the strip label. 19:14-17. In order to use this "freehand" method, the strip label is approximately folded in half. It is submitted that it would be clear to one having ordinary skill in the art upon reading the specification and referring to the associated drawing figures, that the strip layer would be folded in approximately half to form a "V" to enable it to be applied to the edge of the folder. In order to wrap the strip label around the edge of the file folder, and to ensure that an equal portion of the strip label appeared on either side of the file folder about the edge, a user performing the "freehand" method, would have to fold the strip label in approximately half to form a "V." Without forming a "V," it would be difficult to gauge whether the strip label would be applied uniformly about the edge of the file folder. It is submitted that the claim language is sufficiently clear that it would have been apparent to one having ordinary skill in the art that the inventor was in possession of the claimed subject matter at the time of filing the patent application. Accordingly, withdrawal of the rejection of claims 14-17, 35-37 and 45-50 is respectfully requested.

In view of the foregoing terminal disclaimer and remarks, it is submitted that the application is in a condition for allowance, and notification to that effect is earnestly solicited at the Examiner's earliest convenience. The Examiner is invited to contact the undersigned by telephone if any other matters require resolution prior to notification of allowance.

Respectfully submitted,

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